

REMARKS/ARGUMENTS

In the Office Action dated March 25, 2010 (hereinafter, "Office Action"), claim 35 was rejected under 35 U.S.C. § 112, second paragraph. Claims 1-35 were rejected under 35 U.S.C. § 103(a). By this paper, claims 1, 9, 11-14, 16-17 and 35 are being amended.

Applicant respectfully responds to the Office Action.

I. Claim 35 Rejected Under 35 U.S.C. § 112, Second Paragraph

Claim 35 stands rejected under 35 U.S.C. § 112, second paragraph. Specifically, the Office Action indicated that there was insufficient antecedent basis for the term "the second data file" recited in claim 35. (Office Action, page 3). As a result of this paper, claim 35 has been amended to address this issue. Accordingly, Applicant respectfully requests that the rejection of claim 35 under 35 U.S.C. § 112, second paragraph be withdrawn.

II. Claims 1-3, 9-11, 17-19, 25-27, 31 and 32 Rejected Under 35 U.S.C. § 103(a)

Claims 1-3, 9-11, 17-19, 25-27, 31 and 32 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 7,213,060 to Kemp et al. (hereinafter, "Kemp") in view of U.S. Patent No. 6,032,162 to Burke (hereinafter, "Burke"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). As the Board of Patent Appeals and Interferences has recently confirmed, "obviousness requires a suggestion of all limitations in a

claim.” In re Wada and Murphy, Appeal 2007-3733 (citing CFMT, Inc. v. Yieldup Intern. Corp., 349 F.3d 1333, 1342 (Fed. Cir. 2003)).

Independent claim 1 has been amended to recite “determining, after the print job is created, by the client device if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network” and “addressing, after determining the network address of the peripheral device, the peripheral device using the determined network address of the peripheral device, wherein addressing the peripheral device occurs after the communication has been sent over the network.” Support for this claim subject matter is found on page 11, line 8-page 12, line 2 of the filed specification.

The combination of Kemp and Burke does not teach or suggest this subject matter because Kemp does not teach or suggest “wherein addressing the peripheral device occurs after the communication has been sent over the network.” Kemp teaches a system in which a webpage is displayed to the user that contains a hyperlink with the network address of a printer that the user wants to use, and that the user may configure his or her workstation to use the desired printer by clicking on the hyperlink. (See Kemp, col. 7, lines 9-21; col. 2, lines 30-47). As best understood, the Office Action indicates that when the user clicks on the hyperlink, the network address of the printer is “determined.” (Office Action, page 4). However, even assuming for the sake of argument that this interpretation is correct, there is no indication in Kemp that the user determines the network address by sending a communication to the peripheral device over the network, as recited by claim 1.

Moreover, there is also no indication that any communication sent to the peripheral device (printer) in Kemp occurs before the printer has been formally addressed. Rather, the communication between the computer and the printer in Kemp occurs when the computer formally addresses the printer and sends it a print job. However, sending a print job to a printer does not indicate that a communication (to determine whether the proposed network address of the peripheral device is correct) is sent before the printer is formally addressed, as required by amended claim 1.

In the Office Action, the prior rejection based upon Kemp was maintained because, according to the Office Action, there was no indication in the claim that sending a communication to the peripheral device over the network occurs before the peripheral device is formally addressed. (See Office Action, page 2). Applicant respectfully disagrees. However, in order to further prosecution, claim 1 has been amended to indicate a sequential order for the actions recited in claim 1. Specifically, amended claim 1 recites that the “addressing the peripheral device occurs after the communication has been sent over the network.” There is no indication in Kemp that the user determines the network address by sending a communication to the peripheral device over the network and that this communication is sent before the peripheral device has been formally addressed. For this reason, Kemp fails to teach or suggest “determining, after the print job is created, by the client device if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network” and “addressing, after determining the network address of the peripheral device, the peripheral device using the determined network address of the peripheral device, wherein addressing the peripheral device occurs after the communication has been sent over the network,” as required by amended claim 1.

With respect to Burke, this reference teaches that the contents of a file are “parsed” to “identify HTML tags (e.g. Href tags) as URL address codes” and that the form of the address codes is also determined. (Burke, col. 4, line 55-col. 5, line 7). However, there is no indication in Burke that a communication is sent to determine the network address of the peripheral device, and that such a determination of the address of the peripheral device occurs before the peripheral device is formally addressed. For this reason, Burke fails to teach or suggest “determining, after the print job is created, by the client device if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network” and “addressing, after determining the network address of the peripheral device, the peripheral device using the determined

network address of the peripheral device, wherein addressing the peripheral device occurs after the communication has been sent over the network,” as required by amended claim 1.

Amended claim 1 also recites “determining, after the print job is created, a network address of the peripheral device ... wherein determining includes: retrieving, after the print job is created, a first data file ...[,] parsing, after the print job is created, ... the retrieved first data file into one or more portions...[,] comparing, after the print job is created, ... the one or more portions of the retrieved first data file with a predetermined data formatting pattern...[,] identifying, after the print job is created, ... one or more portions of the retrieved first data file as network addresses...[,] [and] determining, after the print job is created, ... if a network address is the network address of the peripheral device.” This amendment to claim 1 indicates a variety of actions that occur in order to “determine ... [the] network address of the peripheral device” and that each of these actions occurs “after the print job is created.” Support for this claim subject matter is found on page 8, line 4-page 12, line 15 of the filed specification.

The combination of Kemp and Burke does not teach or suggest that each of the recited actions associated with “determining ... [the] network address of the peripheral device ... [occurs] after the print job is created,” because the cited reference (Kemp) does not teach retrieving and parsing of information from the webserver after the print job has been created. Specifically, Kemp teaches that “when a new printer is installed on the network, the network administrator generally adds the printer to a listing of printers maintained on a web-server.” (Kemp, col. 6, lines 41-43). In Kemp, the workstation downloads the “printer configuration information and print driver information” from the web-server when the printer is selected by a user. (Kemp, col. 6, lines 32-33). Further, Kemp indicates that “before the user is able to submit the print job to one of printers 40 to 42, necessary print driver and configuration files are required to be installed on workstation 20 in order for workstation 20 to communicate with the selected printer.” (Kemp, col. 4, lines 26-30 (underlining added)). Thus, Kemp indicates that before the user is able to submit the print job and

communicate with the printer, necessary print driver and configuration files are required. To the extent that clicking on Kemp's hyperlink to download the printer information may be interpreted as "determining" the network address of a printer, there is no indication that this process includes retrieving a data file from a webserver, parsing the data file and comparing the data file to determine the network address of the printer, and that all such actions occur after the print job has been created. Kemp teaches that the printer information is ascertained before the print job is submitted, and there is no indication that actions to determine the network address (such as parsing a data file or comparing the parsed data file) occur after a print job has been created. For this reason, Kemp's teachings do not satisfy the present submit matter of claim 1.

For at least the foregoing reasons, Applicant respectfully submits that amended claim 1 is allowable. Claims 2-3, 25-27, 31 and 32 depend from claim 1, and are therefore allowable for at least the same reasons as claim 1.

Amended claim 9 recites instructions being executable to "determine, after the print job is created, by the client device if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network" as well as instructions executable to "address, after determining the network address of the peripheral device, the peripheral device using the determined network address of the peripheral device, wherein addressing the peripheral device occurs after the communication has been sent over the network." Amended claim 9 further recites "determining, after the print job is created, a network address of the peripheral device ... wherein determining includes: retrieving, after the print job is created, a first data file ...[,] parsing, after the print job is created, ... the retrieved first data file into one or more portions...[,] comparing, after the print job is created, ... the one or more portions of the retrieved first data file with a predetermined data formatting pattern...[,] identifying, after the print job is created, ... one or more portions of the retrieved first data file as network addresses...[,] [and] determining, after the print job is created, ... if a network address is the network address of the peripheral device, wherein

determining includes sending a communication over the network.” As discussed above, the combination of Kemp and Burke does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that amended claim 9 is allowable. Claims 10-11 depend from claim 9, and are therefore allowable for at least the same reasons as claim 9.

Amended claim 17 recites “determining, after the print job is created, if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network” as well as “means for addressing, after determining the network address of the peripheral device, the peripheral device using the determined network address of the peripheral device, wherein addressing the peripheral device occurs after the communication has been sent over the network.” Amended claim 17 further recites “means for determining, after the print job is created, a network address of the peripheral device ... wherein determining includes: retrieving, after the print job is created, a first data file ...[,] parsing, after the print job is created, ... the retrieved first data file into one or more portions...[,] comparing, after the print job is created, ... the one or more portions of the retrieved first data file with a predetermined data formatting pattern...[,] identifying, after the print job is created, ... one or more portions of the retrieved first data file as network addresses...[,] [and] determining, after the print job is created, ... if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network.” As discussed above, the combination of Kemp and Burke does not teach or suggest this claimed subject matter. Accordingly, Applicant respectfully submits that amended claim 17 is allowable. Claims 18-19 depend from claim 17, and are therefore allowable for at least the same reasons as claim 17.

III. Claims 4-8, 12-16, 18-24 and 28-30 Rejected Under 35 U.S.C. § 103(a)

Claims 4-8, 12-16, 18-24 and 28-30 stand rejected under 35 U.S.C. § 103(a) based on Kemp in view of Burke in further view of U.S. Patent Application Publication No. 2002/0059489 to Davis

et al. (hereinafter, "Davis"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

Claims 4-8 and 28-30 depend from claim 1. Claims 12-16 depend from claim 9. Claims 18-24 depend from claim 17. As discussed above, Applicant respectfully submits that claims 1, 9 and 17 are allowable. Accordingly, Applicant respectfully submits that claims 4-8, 28-30, 12-16 and 18-24 are allowable for at least the same reasons as presented above in connection with claims 1, 9 and 17, respectively.

IV. Claim 33 Rejected Under 35 U.S.C. § 103(a)

Claim 33 stands rejected under 35 U.S.C. § 103(a) based on Kemp in view of Burke in further view of U.S. Patent No. 7,168,003 to Lozano et al. (hereinafter, "Lozano"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

Claim 33 depends from claim 1. As discussed above, Applicant respectfully submits that claim 1 is allowable. Accordingly, Applicant respectfully submits that claim 33 is allowable for at least the same reasons as presented above in connection with claim 1.

V. Claim 34 Rejected Under 35 U.S.C. § 103(a)

Claim 34 stands rejected under 35 U.S.C. § 103(a) based on Kemp in view of Burke in further view of U.S. Patent Application Publication No. 2003/0055874 to Simpson (hereinafter, "Simpson"). Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

Claim 34 depends from claim 1. As discussed above, Applicant respectfully submits that claim 1 is allowable. Accordingly, Applicant respectfully submits that claim 34 is allowable for at least the same reasons as presented above in connection with claim 1.

VI. Claim 35 Rejected Under 35 U.S.C. § 103(a)

Claim 35 stands rejected under 35 U.S.C. § 103(a) based on Kemp in view of Burke in further view of Simpson and Lozano. Applicant respectfully requests reconsideration in view of the above claim amendments and the following remarks.

The standard to establish a *prima facie* case of obviousness is provided above.

Amended claim 35 recites “determining, after the print job is created, by the client device if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network” and “addressing, after determining the network address of the peripheral device, the peripheral device using the determined network address of the peripheral device, wherein addressing the peripheral device occurs after the communication has been sent over the network.” Amended claim 35 further recites “determining, after the print job is created, a network address of the peripheral device ... wherein determining includes: retrieving, after the print job is created, a first data file ...[,] parsing, after the print job is created, ... the retrieved first data file into one or more portions...[,] comparing, after the print job is created, ... the one or more portions of the retrieved first data file with a predetermined data formatting pattern...[,] identifying, after the print job is created, ... one or more portions of the retrieved first data file as network addresses...[,] [and] determining, after the print job is created, ... if a network address is the network address of the peripheral device, wherein determining includes sending a communication over the network.”

As discussed above, the combination of Kemp and Burke does not teach or suggest this claimed subject matter. The Office Action has not cited any portion of Simpson or Lozano that

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would allegedly teach this claim subject matter. Accordingly, Applicant respectfully submits that amended claim 35 is allowable.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that all pending claims in the present application are in a condition for allowance, which is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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